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### REMARKS

This Amendment is responsive to the Office Action identified above, and is responsive in any other manner indicated below.

### SUPPLEMENTAL REISSUE OATH/DECLARATION

Regarding the page 2 rejection of claims 15-40 concerning a defective declaration, Applicant respectfully submits that a supplemental reissue oath/declaration will be filed at the end of prosecution when all other issues/rejections have been resolved and no more claim or other changes are to be made. Accordingly, when the supplemental reissue oath/declaration becomes the only issue barring allowance of the application, the Examiner is invited to call the undersigned at the local Washington, D.C. telephone number of 703-312-6600 to provoke accelerated preparation/filing of the final supplemental reissue oath/declaration to move the application to allowance.

### PENDING CLAIMS

Appropriate claims have been amended, canceled and/or added (without prejudice or disclaimer) in order to adjust a clarity and/or (correcting improper) renumbering of Applicant's claimed invention. At entry of this paper, Claims 1-14 and 37-62 will be pending for further consideration and examination in the application.

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### RENUMBERING OF CLAIMS

With regard to the objection regarding the prior improper renumbering of claims (as set forth within the "Numbering of Claims" section), the claims have been returned to their original proper numbering, and reissue status identifiers added. Reconsideration and withdrawal of the objection, are respectfully requested.

### REJECTION UNDER '112, 1st PAR. - TRAVERSED

Claims 28-32 have been rejected under 35 USC '112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully reiterates the following Office Action concern(s) and follows with Applicant's traversal:

Office Action Concern:

Concerning claim 28, the Spec does not teach only two suspension leads...

Applicant's Traversal: Applicant respectfully submits that support for two leads is clearly shown in example FIG. 32 showing two intersecting leads (widened at a central portion thereof).

Office Action Concern:

Concerning claims 29 and 34, the Spec does not teach only two suspension leads intersecting at right angles...

Applicant's Traversal: Applicant respectfully submits that support for two leads is clearly shown in example FIG. 32 showing two intersecting leads (widened at a central portion thereof), which intersect at right angles.

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Office Action Concern:

Concerning claims 30, 32, 35 and 37, the terms "tetragonal shape" are not taught in the specification.

Applicant's Traversal: Webster's II New College Dictionary, copyright 1999, at page 1141, defines a "tetragon" as "a four-sided polygon". It is respectfully submitted that IC chips are almost universally provided as "tetragonally shaped". Applicant's FIG. 29, for example, has illustration of a "tetragonally-shaped" IC. Accordingly, it is respectfully submitted that "tetragonally shaped" is supported, and well known by persons skilled in the art. Even if the word "tetragonally" is not written within the specification, MPEP 2163 (directed to "written description" guidelines) itself, explicitly states "...there is no in haec verba requirement..." (i.e., "in the same words" requirement) with respect to "written description", and continues to state simply that "...newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure."

As the foregoing is believed to have addressed all '112, 1<sup>st</sup> paragraph concerns, reconsideration and withdrawal of the '112, 1<sup>st</sup> paragraph rejection are respectfully requested.

**"PROVISIONAL" DOUBLE-PATENTING**

It is respectfully noted that the present double-patenting rejection is only a "provisional" double-patenting rejection. As a result, Applicant respectfully submits a traversal, but refrains from commenting further on a substance of the rejection at this time, until an actual double-patenting rejection is made.

If a situation arises where the only remaining issue blocking allowance is the double-patenting rejection(s), the Examiner is herein requested to telephone the

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Undersigned at the local Washington, D.C. area telephone number of 703-312-6600, for the possible immediate preparation/filing of a terminal disclaimer to move the application to allowance.

### RECAPTURE REJECTION - TRAVERSED

For the purposes of the following discussions, the previously-pending proper claim numbers will be used to identify the specific claims now properly renumbered herein.

The recapture rejection of Claims 37-63 as set forth within the section numbered "4" beginning on page 3 of the Office Action (and/or within prior Office Actions) is respectfully traversed.

**It is respectfully submitted that the standing recapture rejection appears to be based upon old case-law, in that the rejection is improper and a number of old legal cases are cited in support of the recapture rejection. More particularly, in contrast to the cited older cases, *ex parte Eggert*, Appeal No. 2001-0790, decided 29 May 2003 provides the legal analysis that should be applied/followed for recapture analysis. The *Eggert* discussions/analysis provided in Applicant's prior papers has been further elaborated upon in the following.**

***ex parte Eggert* discussion:**

More particularly, the relatively-recent precedential USPTO Board opinion of *ex parte Eggert*, Appeal No. 2001-0790, was decided 29 May 2003, concerning US Patent No. 5,577,426. In such case, the Board **REVERSED** the **Examiner's attempt to apply recapture to reject the application.** Background teaching of the *Eggert*

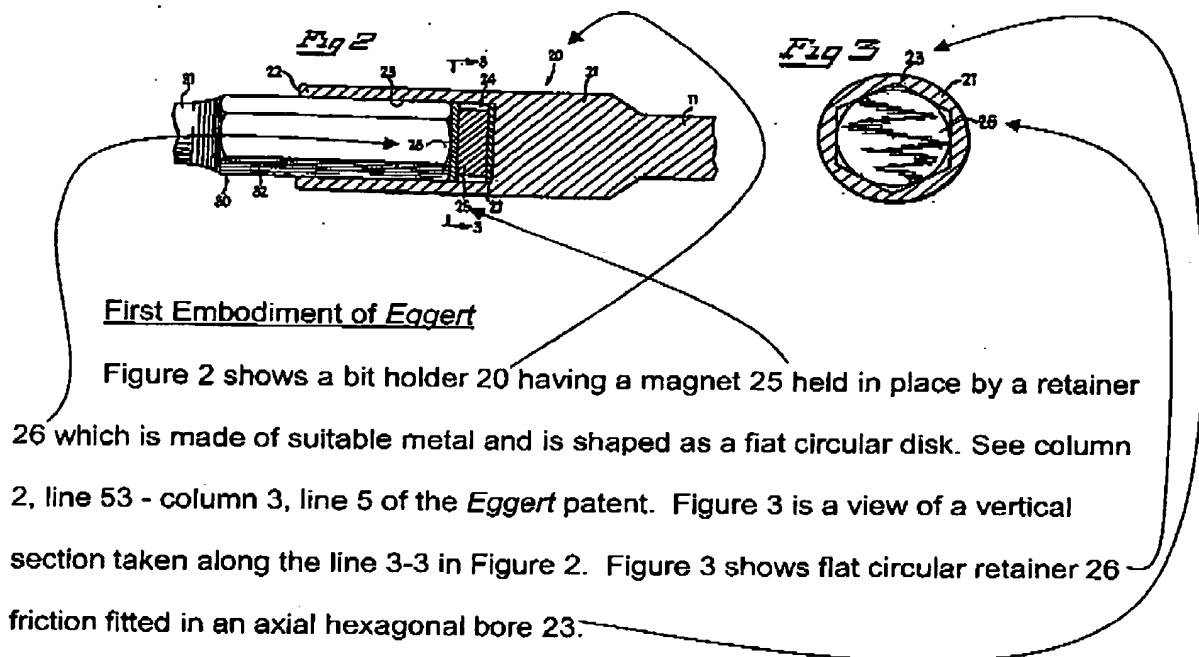
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opinion is relevant for understanding of traversal/rebuttal of the present rejection in Applicant's application.

The invention in *Eggert* was related to a magnetic bit holder. Two embodiments were at issue in *Eggert's* appeal; such two embodiments are briefly described on the next two pages.

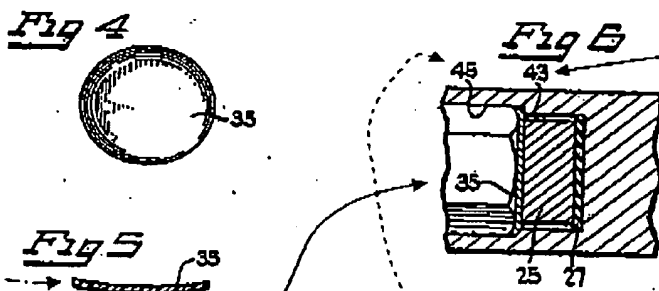
The first embodiment is shown in *Eggert's* FIGS. 2 and 3 as follows:



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The second embodiment is shown in *Eggert's* FIGS. 4, 5 and 6 as follows:



#### Second Embodiment of Eggert

In the second embodiment, an alternative bit holder is shown which is similar to bit holder 20 in the first embodiment, except the nature of the bore and retainer are different. More specifically, the bit holder of Figure 6 has a cylindrical body which has a circularly cylindrical axial bore 43 in addition to a hexagonal bore 45.

See column 3, lines 48-55.

Figure 6 shows that magnet 25 is dimensioned to fit freely in the cylindrical bore 43 and is held in place by a retainer 35 friction fitted in the hexagonal bore 45.

See column 3, lines 59-64. Figures 4-6 show that the retainer 35 is formed of suitable plastic material and generally bowl-shaped and convex toward the magnet.

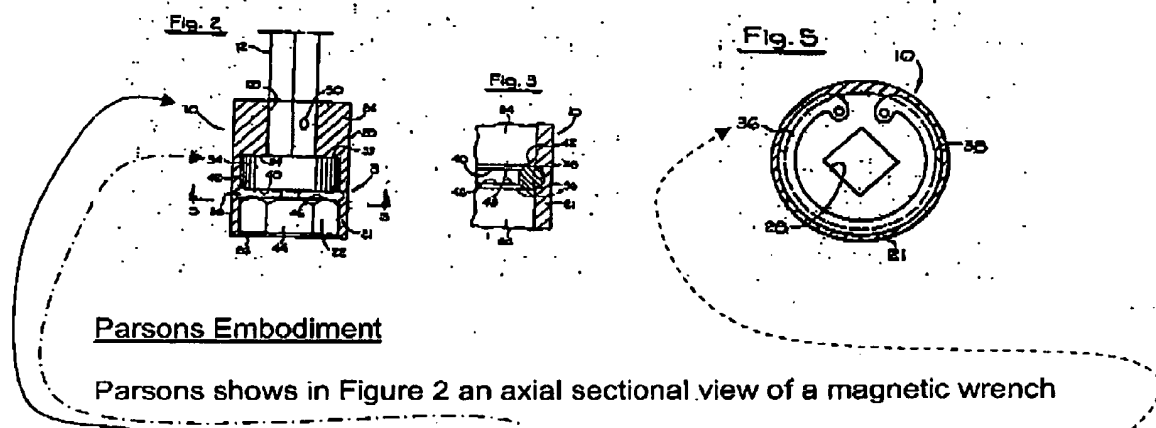
See column 3, lines 35-47.

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*Eggerl's* original independent claim 1 recited the language "retaining structure in contact with the outer surface of said magnet and interference fitted in said bore to retain said magnet in said bore." Original claim 1's limitations, thus, encompassed *Eggerl's* both first and second embodiments.

In a rejection, the *Eggerl* Examiner applied Parsons, US Patent No. 4,663,998 (shown as follows), for a teaching of the broadly claimed retaining structure.



Parsons Embodiment

Parsons shows in Figure 2 an axial sectional view of a magnetic wrench socket 10. Figure 2 shows magnet 34 held in a cylindrical bore using of a C ring 36. See column 1, lines 35-65, of Parsons. Figure 3 of Parsons is a large scale sectional view of a portion of Figure 2 indicated by arrow 3. Figure 3 shows the C ring 36 releasably held in a peripheral groove 38 formed in the wall 21. See column I, lines 29 and 30, and lines 60-65. Figure 5 of Parsons shows a sectional view taken at line 5-5 of Figure 2 and shows C ring 36 releasably held in peripheral groove 38 formed in the wall 21. See column 1, lines 34 and 35, and lines 60-65. Thus, Parsons describes what in essence is a third (cited prior art) embodiment covered by the language of *Eggerl's* original claim 1.

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In response to the Examiner's rejections applying Parsons to the claimed retaining structure, *Eggert's* applicant eventually rewrote non-art-rejected dependent claim 6 into independent form. Claim 6 added the limitation of "said retaining member being generally bowl-shaped and convex toward said magnet" to claim 1. This claim language corresponds only to the second embodiment disclosed in Figures 4, 5 and 6. That is, note that such non-generic language excluded *Eggert's* disclosed first embodiment which is a flat, circular metal disk 6. The Examiner entered the amendment and appeared to allow the application on a basis of such "bowl-shaped and convex" feature/limitations, and the *Eggert* patent issued.

Attached herewith is an appendix sheet titled "Eggert Analysis". A right-hand column of such "Eggert Analysis" sheet reiterates the issued claim 1, with gray highlighting within such claim indicating the feature/limitations which appeared to gain allowance. Again, remember that such overly-narrow features/limitations did NOT cover Applicant's first (FIGS. 2-3) flat, circular metal disk 6 embodiment.

Subsequently (i.e., post-issuance), *Eggert's* applicant attempted to correct the overly-narrow claim limitation by reissue. More particularly, *Eggert's* applicant presented new reissue independent claims 15 and 22 which were of sufficient scope to not only cover both of their disclosed FIGS. 2-3 (flat metal disk) and FIGS. 4-6 (bowl-shaped, convex disk) embodiments, but also distinguish over the C ring of Parsons. For example, the new language of claim 15 (shown in the center column of the attached "Eggert Analysis" sheet) reads "a discrete retaining member friction fitted in said bore outboard of said magnet and substantially covering said outer surface of said magnet to retain said magnet in the bore." The scope of this language included both the first and second embodiments of *Eggert's* invention, and



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as recognized by the *Eggert* Examiner, was free of the prior art of record. But note from viewing the attached *Eggert* analysis sheet, that such claim was attempting to delete the "bowl-shaped and convex" feature/limitations (see encircled portions) which were instrumental in gaining allowance.

*Eggert's* application (like the present application), was then rejected based on the "reissue recapture rule". On a first round of USPTO appeal, the *Eggert* Examiner asked an initial 3-person USPTO Board to impose a per se rule of reissue recapture to prevent the *Eggert* Appellant from retreating from any claim limitation determined to have secured allowance of the original patent. The Examiner LOST (i.e., was reversed) in the first round of appeal. After losing upon decision of a 3-person Board, the *Eggert* Examiner then requested and got a second round full-Board-panel reconsideration and urged the full Board to reverse the prior decision and to adopt the *per se* rule. The full-Board also rejected the per se rule, reversing the examiner to ultimately allow the *Eggert* Appellant to use reissue to retreat from the original overly limiting claim limitations.

The *Eggert* decision may be interpreted as follows. More particularly, attention is directed again to the attached "Eggert Analysis" sheet, wherein circles or Venn diagrams may be used in explanation/analysis of recapture. Attention is directed to the Venn diagram at the top of the "Eggert Analysis" sheet. The issued claim (right-hand column of the "Eggert Analysis" sheet) has a narrowest scope as shown representatively by the smaller (inner) Venn diagram circle. In contrast, the surrendered claim (left-hand column of the "Eggert Analysis" sheet) not having the allowable features/limitations (of the issued claim), has the broadest scope as shown representatively by the larger (outer) Venn diagram circle. The *Eggert* decision

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states that the grayed Venn diagram area represents intermediate claim features/limitations/scope which have NOT YET BEEN CONSIDERED BY THE EXAMINER DURING PROSECUTION, AND BECAUSE IT HAS NOT BEEN CONSIDERED, IT HAS NOT BEEN SURRENDERED BY APPLICANT. That is, since it has not been considered/surrendered, a reissue Applicant can freely claim within this grayed area WITHOUT VIOLATING RECAPTURE.

Note with respect to reissue claim 15 (center column) on the "Eggert Analysis" sheet, that the full Board reversed the examiner's recapture rejection concerning the disputed limitations (see circled portion of the center and right columns of "Eggert Analysis" sheet), and allowed Eggert's reissue applicant to actually back away from the features/limitations which gained the allowance of the original issued claim. The important teaching to comprehend, is that, as long as a reissue claim is of intermediate scope (grayed Venn diagram area) between the surrendered claim and issued claim, then the reissue claim DOES NOT VIOLATE THE RECAPTURE RULE. (As will be seen ahead, Applicant's reissue claims are likewise of intermediate scope between the surrendered and issued claims.)

The effect of the Eggert decision was that *Egger's* Appellant was not limited to the "retaining member being generally bowl-shaped and convex toward said magnet" limitations of the patented claims. Instead, *Egger's* applicant was able to obtain intermediate new reissue independent claims 15 and 22 which recited, for example, "a discrete retaining member friction fitted in said bore outboard of said magnet and substantially covering said outer surface of said magnet to retain said magnet in the bore." The scope of this language included both of *Egger's* FIGs. 1-2 and FIGs. 4-6 embodiments. Thus, to summarize, Reissue applicants are NOT

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frozen at the scope of patented claims, but instead, Reissue may be used to pursue intermediate scope claims to supplement and/or broaden erroneous (e.g., overly restrictive) claims. This Board finding makes sense in that, if a *per se* reissue recapture rule were always applied/applicable, such would totally negate any need for a reissue procedure within the USPTO.

Even going beyond the *Eggert* decision, one of the permissible actions of the reissue statute is to enable the addition of claims to subject matter not claimed in the original patent. More particularly, MPEP 1412.01 allows a reissue Applicant to claim an invention which was disclosed within Applicant's original disclosure, even if it was not claimed in the original patent. That is, MPEP 1412.01 states (in relevant part), "The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does not mean that the invention claimed in the reissue must have been claimed in the original patent..." [Emphasis added.] Thus, MPEP 1412.01 clearly states that a differing invention (not claimed within the original patent claims) can be subsequently claimed within a reissue application. It is respectfully submitted that there is no mention of "recapture" within MPEP 1412.01.

Office Action comments associated with the "recapture" rejection, appears to give the impression that the Examiner/USPTO is setting forth a position (based upon "recapture") that a "new invention" reissue claim must contain all the prior (amendment) limitations of the patent claims PLUS the features/limitations of the "new invention". Traversal is appropriate, because the above-mentioned MPEP 1412.01 provisions clearly allow "new invention" reissue claims. The apparent Office Action comments proposal would (in effect) only permit narrowing "same claimed

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invention" claims, in that a reissue applicant would be required to start with the patented claims and then add limitations with respect to the "new invention". It is respectfully submitted that to accept the apparent Office Action comments proposal would render MPEP 1412.01 meaningless, i.e., there never would be any "new invention" claims, in that there would only result "prior patented invention" claims which are further narrowed with the "new invention" limitations.

Evidence beyond the MPEP 1412.01 text also shows that "new invention" claims are permitted within reissues without involving "recapture. For example:

In the legal case of *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1354, 48 USPQ2d 1225, 1234 (Fed. Cir. 1998), a reissue patent was allowed to add claims individually to a needle (for use in a biopsy gun), whereas the original patent claimed only a biopsy gun and needle combination. Clearly in *Bard*, the reissue applicant was allowed "new invention" claims which omitted major features of the patented claims.

In the legal case of *In re Mead*, 198 USPQ 412 (CCPA 1978) [explicitly cited within the MPEP 1412.01 section], the examiner noted that reissue claims 4, 9 and 10 were directed to an independent and distinct invention not claimed in the original patent on the basis they "require a specific vibrating means which the claims of the original patent do not require and the claims of the original patent require fluid dispensing means or two different type of bristles which claims 4, 9 and 10 do not require". Despite the reissue claims 4, 9 and 10 having omitted patented features/limitations, "recapture" was not an issue

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within such legal case. Instead, the subject reissue claims 4, 9 and 10 failed in that MPEP 1412.01 further states that any intent (expressed within the original application, or during prosecution history) "not to claim" a specific type of claims, will work to bar those as reissue claims. That is, Mead's reissue applicant had inadvertently submitted a "not to claim" admission, so that "intent not to claim" (not "recapture") blocked such claims.

MPEP 1412.02(d)(III) presents an example where a reissue may be filed for "computer-readable medium" claims, where original patented claims were directed to "machine claims". It is respectfully submitted that "computer-readable medium" claims will obviously omit limitations which the patented "machine claims" include (and the "machine claims" will omit limitations which the "computer-readable medium" claims include). It is respectfully submitted that there is no mention of "recapture" within MPEP 1412.02(d)(III).

In the legal case of *In re Rowand*, 187 USPQ 487, the question was whether a reissue applicant could obtain reissue claims directed to a "method", where the original patented claims were directed to "tubing" devices. "Recapture" was not an issue within such legal case.

As will be seen in the discussions ahead, Applicant's claims 37-59 are directed toward the addition of claims to subject matter not claimed in the original patent.

Regarding claiming subject matter not claimed in the original patent, MPEP §1412.01 states that claims presented in a reissue application are considered

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to satisfy the requirement of 35 USC §251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 USC §112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter presented in the reissue application.

For convenience, these will be referred to as "§251's requirement (A)" and "§251's requirement (B)" in the discussions ahead.

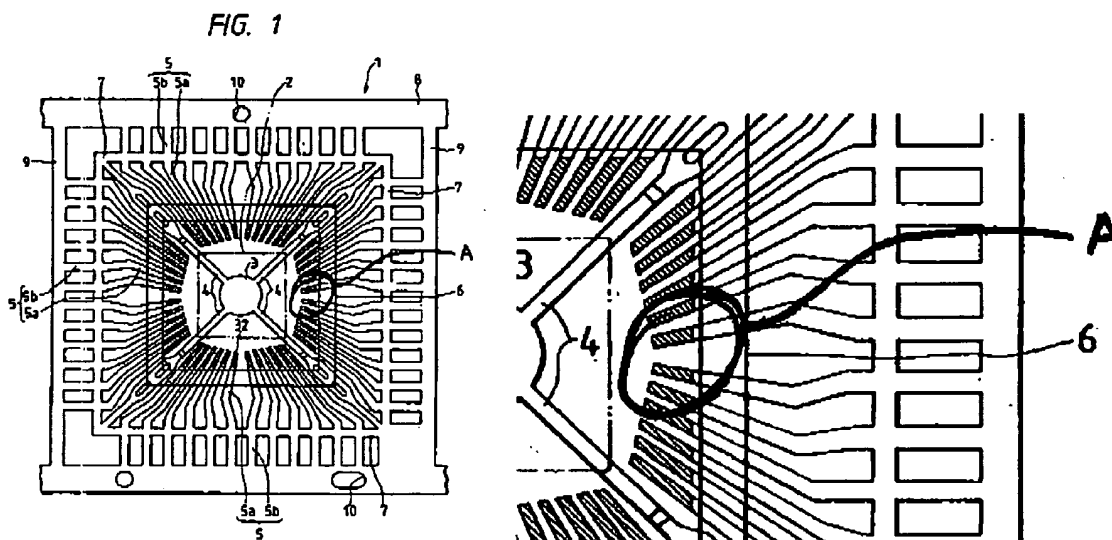
Claims 37-43 and 60-62:

Discussion turns now to the application at hand, and first to Claims 37-43 and 60-62. The 35 USC §251 recapture rejection of Applicant's claims 37-43 is respectfully traversed. More particularly, as mentioned above, MPEP §1412.01 explicitly allows a reissue Applicant to claim an invention disclosed within Applicant's original disclosure even if it was not claimed in the original patent. Applicant's Claims 37-43 and 60-62 invention are directed toward a "framed insulating tape" combination invention.

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That is, independent Claims 37, 40 and 42 (and claims dependent therefrom) claim embodiments (e.g., Applicant's FIG. 1 reproduced below) "wherein a size of said chip mounting portion (3) is smaller than that of said semiconductor chip, and wherein said insulating tape (6) has a frame shape and is continuously formed between said suspension leads and said plurality of leads (5a)."



Applicant's FIG. 1 Embodiment

Such "insulating tape" feature (like the "needle" of the *C.R. Bard, Inc. v. M3 Systems, Inc.* case mentioned above) was not claimed within the patented claims, but is now sought to be claimed within Applicant's reissue application as a combination invention together with a small chip mounting portion (*i.e.*, pad).

It is noted (as such may be relevant to traversal discussions ahead) that Applicant's disclosed "insulating tape" embodiment includes gold (Ag) plated wire bonding regions 32 (shown enlarged, for example, in the circled region "A" above, as the darkened cross-hatched areas). Such regions 32 allow important wire bonding,

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to facilitate wiring connections between ones of the leads 5a and connection spots on the die.

Regarding §251's requirement (A) mentioned above, Applicant's FIGs. 1, 8, 11a, 12, 13, 15, 16, 18, 21, 23, 24, 29 clearly illustrate arrangements "wherein a size of said chip mounting portion is smaller than that of said semiconductor chip, and wherein said insulating tape has a frame shape and is continuously formed between said suspension leads and said plurality of leads." Even beyond illustration within the FIGs., Applicant's patented column 5, last full paragraph, also describes Applicant's "frame-shaped tape 6." Accordingly, it is respectfully submitted that §251's requirement (A) that the invention (described in the claims presented in the reissue application) be described in the original patent specification and enabled by the original patent specification such that 35 USC §112 first paragraph is satisfied, has been met. Regarding §251's requirement (B), it is respectfully submitted that nothing in Applicant's patent specification indicates intent not to claim such combination invention subject matter. Hence, both requirements (A) and (B) of 35 USC §251, that the claims be "for the invention disclosed in the original patent," have been satisfied, making Claims 37-43 proper claims/subject matter for this reissue.

In conclusion, it is respectfully submitted that such Claims 37-43 and 60-62 (i.e., like the *Eggert* and *C.R. Bard, Inc.* opinions discussed above), correct an error within the patent of not having claimed a framed "insulating tape" combination invention. Accordingly, reconsideration and withdrawal of the "recapture" of such claims, are respectfully requested.



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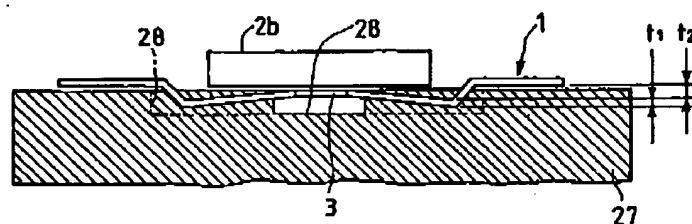
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Claims 44-49:

The 35 USC §251 recapture rejection of Applicant's Claims 44-49 is respectfully traversed. More particularly, as mentioned above, MPEP §1412.01 explicitly allows a reissue Applicant to claim an invention disclosed within Applicant's original disclosure, even if it was not claimed in the original patent. Applicant's Claims 44-49 invention are directed toward a "spaced suspension lead" combination invention.

That is, independent Claims 44 (and Claims 45-48 dependent therefrom) claim embodiments (e.g., Applicant's FIG. 28(a) reproduced below) "wherein a size of said chip mounting portion is smaller than that of said semiconductor chip, and wherein said semiconductor chip is mounted on said chip mounting portion, such that said rear surface of said semiconductor chip is bonded to the side of said first surface of said chip mounting portion by an adhesive layer, and such that a part of each of said suspension leads, which is located under said semiconductor chip, is spaced from said rear surface of said semiconductor chip."

FIG. 28(a).



Independent claim 49 has alternative, but similar, limitations regarding resin between the chip and spaced suspension leads.

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Such "spaced suspension lead" feature (like the "needle" of the *C.R. Bard, Inc. v. M3 Systems, Inc.* case mentioned above) was not claimed within the patented claims, but is now sought to be claimed within Applicant's reissue application as a combination invention together with a small chip mounting portion (*i.e.*, pad).

The spaced suspension lead feature is advantageous in that resin gets to directly adhere to increased areas of a backside (*i.e.*, bottom) of a mounted die. Since adhesion of the interface between the semiconductor chip (of silicon) and the resin is stronger than that of any interface between the die pad (of metal) and the resin, moisture (which turns to steam during solder reflow and induces cracking) can be prevented from invading into an interface between the die pad and resin. Thus, it is possible to suppress moisture and thus package body cracking which might otherwise be caused when the LSI package is to be mounted on a substrate by solder reflow.

Regarding §251's requirement (A) mentioned above, Applicant's FIG. 28(a) clearly illustrates an arrangement "wherein a size of said chip mounting portion is smaller than that of said semiconductor chip, and wherein ... a part of each of said suspension leads, which is located under said semiconductor chip, is spaced from said rear surface of said semiconductor chip." Accordingly, it is respectfully submitted that §251's requirement (A), that the invention (described in the claims presented in the reissue application) be described in the original patent specification and enabled by the original patent specification such that 35 USC §112 first paragraph is satisfied, has been met. Regarding §251's requirement (B), it is respectfully submitted that nothing in Applicant's patent specification indicates intent not to claim such combination invention subject matter. Hence, both requirements

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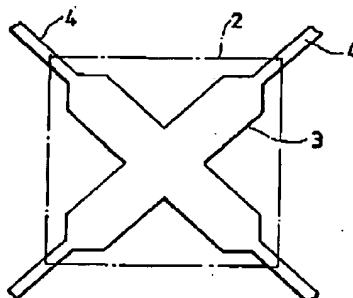
(A) and (B) of 35 USC §251 that the claims be "for the invention disclosed in the original patent" have been satisfied, making Claims 44-49 proper claims/subject matter for this reissue.

In conclusion, it is respectfully submitted that such Claims 44-49 (*i.e.*, like the *Eggert* and *C.R. Bard, Inc.* opinions discussed above), correct an error within the patent of not having claimed a "spaced suspension lead" combination invention. Accordingly, reconsideration and withdrawal of the "recapture" rejection of such claims, are respectfully requested.

Claims 50-59:

The 35 USC §251 recapture rejection of Applicant's claims 50-59 is respectfully traversed. More particularly, as mentioned above, MPEP §1412.01 explicitly allows a reissue Applicant to claim an invention disclosed within Applicant's original disclosure even if it was not claimed in the original patent. Applicant's Claims 50-59 are directed toward a "(flag-less) suspension lead" combination invention as shown by Applicant's FIG. 32 as follows:

FIG. 32



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That is, the claim embodiments of Independent Claim 50 (and Claims 51-54 dependent therefrom), e.g., Applicant's FIG. 32 reproduced above, include "a first suspension lead for supporting said semiconductor chip, extending in a first direction; a second suspension lead for supporting said semiconductor chip, extending in a second direction which is different from said first direction, said second suspension lead intersecting said first suspension lead; and...wherein said semiconductor chip is disposed on said intersecting portion of said first and second suspension leads, wherein a width of each of said first and second suspension leads at the vicinity of said intersecting portion is wider than that of each said first and second suspension leads at vicinities beyond said semiconductor chip, and wherein said rear surface of said semiconductor chip is fixed to said first and second suspension leads at the vicinity of said intersecting point by an adhesive." That is, it is respectfully noted that there is no "chip mounting portion" claimed. Independent Claim 55 (and claims dependent therefrom) have analogous limitations.

That is, for a proper understanding of Claims 50-59, an initial discussion of patented Independent Claim 1 may be helpful/appropriate, and hence, such discussion is now provided herewith as follows. More particularly, independent Claim 1 recites "a leadframe having: a chip mounting portion for mounting said semiconductor chip; suspension leads unitarily formed with said chip mounting portion, a width of said chip mounting portion being wider than a width of each of said suspension leads." That is, note that there is both a mounting portion and suspension leads.

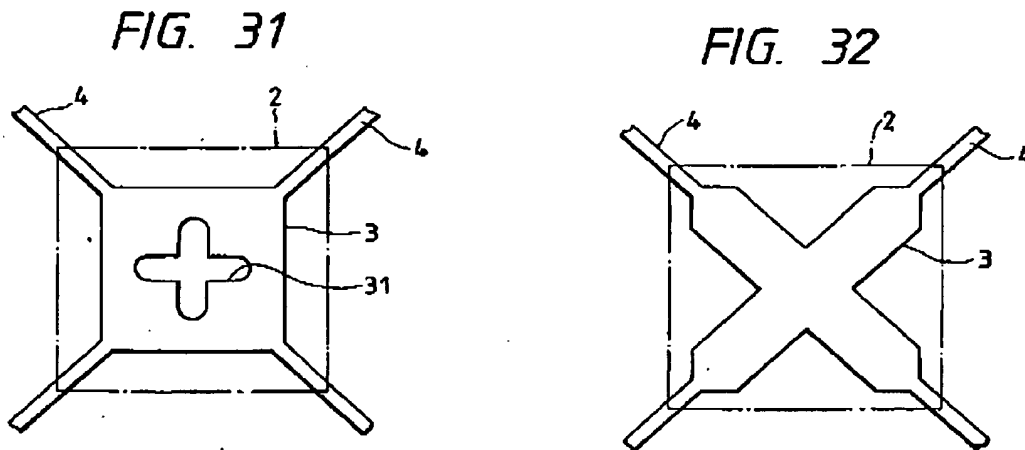
Subsequent review of such claim related to the present reissue process revealed that such Claim 1 limitations may be too narrow. More particularly, a

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potential infringer might (in a bid to avoid infringement) leave out the "chip mounting portion" or "flag", and then attempt an argument that the claimed "chip mounting portion" covered "flagged" chip supporting arrangements, but did not cover "flag-less" chip supporting arrangements. Not covering a "flag-less" arrangement is another error within the present patent, which is attempted to be corrected by the present Reissue application.

Description/understanding of "flagged" verses "flag-less" may be helpful in understanding the present situation; hence, attention is now directed to the following Applicant's FIGS. 31-32 for a "flagged" verses "flag-less" explanation:



Applicant's FIGS. 31 and 32

Applicant's FIG. 31 represents a "flagged" arrangement as is understood by persons skilled in the art (*i.e.*, note that the rectangle in FIG. 31 resembles a flag; in the art, the flag may also be circular as will be shown ahead); in contrast, Applicant's FIG. 32 represents a "flag-less arrangement.

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"Flag" and "flag-less" terminology is known in the art, as Djennas *et al.*'s (U.S. Patent No. 5,327,008; of record) illustrates/describes a plurality of differing die-supporting arrangements, including rectangular mini-flag, circular mini-flag AND flag-less arrangements. Djennas *et al.*'s column 6, lines 14-21, describes that Djennas *et al.*'s "FIG. 4 illustrates, in a top-down plan view, portions of a lead frame 40 having such a mini-flag 42. Mini-flag 42 is kept smaller in area than a semiconductor die (illustrated in phantom as line 44) to keep the total interface area between the mini-flag and a plastic encapsulation material (not illustrated) smaller than in conventional devices." Next, Djennas *et al.*'s column 6, lines 45-48, describes that the above-reproduced "...FIG. 6 portions of a lead frame 50 (only partially illustrated) can include a round mini-flag 52 to support a large die (illustrated in phantom as line 54)."

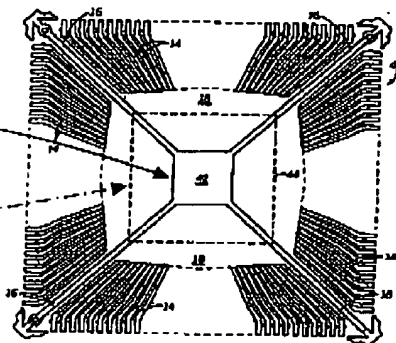


FIG. 4

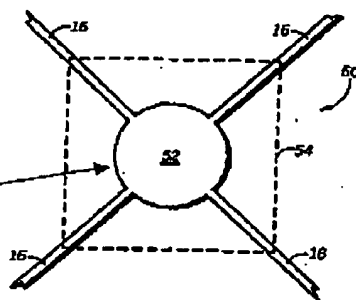


FIG. 6

Most importantly, and most relevant to the present situation, Djennas *et al.*'s column 4, lines 35-37, describes that Djennas *et al.*'s "...FIG. 1 [reproduced herewith] device 10 does not employ a flag. Instead, die 20 rests on tie bars 16." Accordingly, the Djennas *et al.* FIG. 1 arrangement is a "flag-less" arrangement somewhat similar to Applicant's FIG. 32.

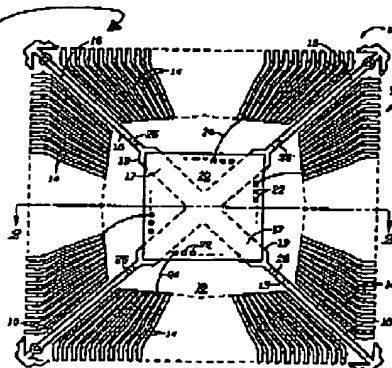


FIG. 1

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[It is noted that Djennas *et al.* is removeable as prior art, given that it has an effective filing date of 22 March 1993, whereas Applicant's foreign priority application has a filing date of 27 March 1992.]

Accordingly, with the above understanding of "flagged" verses "flag-less", Applicant's present independent Claims 50 and 55 (and claims dependent therefrom) are directed toward claiming a semiconductor device utilizing a "flag-less" arrangement (as was mentioned previously).

Regarding §251's requirement (A) mentioned above, Applicant's FIG. 32 clearly illustrate a flagless arrangement. Accordingly, it is respectfully submitted that §251's requirement (A), that the invention described in the claims presented in the reissue application be described in the original patent specification and enabled by the original patent specification such that 35 USC §112 first paragraph is satisfied, has been met. Regarding §251's requirement (B), it is respectfully submitted that nothing in Applicant's patent specification indicates intent not to claim such combination invention subject matter. Hence, both requirements (A) and (B) of 35 USC §251 that the claims be "for the invention disclosed in the original patent" have been satisfied, making claims 50-59 proper claims/subject matter for this reissue.

In conclusion, it is respectfully submitted that such Claims 50-59 (*i.e.*, like the *Eggert* and *C.R. Bard, Inc.* opinions discussed above), correct an error within the patent of not having claimed a "(flag-less) suspension lead" combination invention as shown by Applicant's FIG. 32. Accordingly, reconsideration and withdrawal of the "recapture" rejection of such claims are respectfully requested.

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### **EXTENSIVE PROSECUTION NOTED**

Applicant and the undersigned respectfully note the extensive prosecution which has been conducted to-date with the present application, and thus Applicant and the undersigned would gratefully appreciate any considerations or guidance from the Examiner to help move the present application quickly to allowance.

### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer. That is, any above statements, or any present amendment or cancellation of claims (all made without prejudice or disclaimer), should not be taken as an indication or admission that any objection/rejection was valid, or as a disclaimer of any scope or subject matter. Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

### **EXAMINER INVITED TO TELEPHONE**

The Examiner is invited to telephone the undersigned at the local D.C. area number 703-312-6600, to discuss an Examiner's Amendments or other suggested action for accelerating prosecution and moving the present application to allowance.



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### CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that all claims in this reissue application are now in condition for allowance. Accordingly, allowance of all such claims is respectfully requested.

Applicant respectfully petitions the Commissioner for an appropriate extension of the shortened statutory period for response set by the Office Action dated 29 March 2004. A Form PTO-2038 authorizing payment of the requisite Petition and claim fees also is attached hereto. Please charge any deficits in fees to ATS&K Deposit Account No. 01-2135 (as Order No. 501.32049RV2).

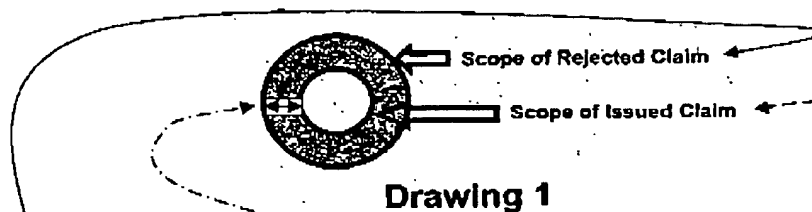
Respectfully submitted,



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Attachments:

## EGGERT ANALYSIS



Drawing 1

### REJECTED (SURRENDERED) CLAIM

Eggert's Independent claim 1 after first amendment of interest (additions in *italics*)

A bit holder comprising:

a cylindrical body having a distal end surface and an axis, said body having formed in said end surface an axial bore terminating at an inner end surface,

a permanent magnet received in said bore and having an outer surface, and

retaining structure in contact with the outer surface of said magnet and interference fitted in said bore to retain said magnet in said bore,

said bore having a portion of non-circular transverse cross section outboard of said retaining structure defining a bit-receiving socket

said retaining structure including a discrete retaining member friction fitted in said bore outboard of said magnet,

said retaining member and said inner end surface cooperating to retain said magnet therebetween.

### REISSUE (INTERMEDIATE) CLAIM

Eggert's reissue claim 15 (compared to issued claim 1; deletions in strikeout; additions in underline)

A bit holder comprising:

a cylindrical body having a distal end surface and an axis, said body having a bore formed in said end surface an axial bore terminating at an inner end surface,

a permanent magnet received in said bore and having an outer surface, and

a discrete retaining structure in contact with the outer surface of said magnet and interference member friction fitted in said bore outboard of said magnet and substantially covering said outer surface of said magnet to retain said magnet in said bore,

said bore having a portion of non-circular transverse cross section outboard of said retaining structure member defining a bit-receiving socket,

said retaining structure including a discrete retaining member friction fitted in said bore outboard of said magnet,

said retaining member being generally bowl-shaped and convex towards said magnet,

said retaining member and said inner end surface cooperating to retain said magnet therebetween.

### ISSUED CLAIM

Eggert's issued independent claim 1 of '426 patent

A bit holder comprising:

a cylindrical body having a distal end surface and an axis, said body having formed in said end surface an axial bore terminating at an inner end surface,

a permanent magnet received in said bore and having an outer surface, and

retaining structure in contact with the outer surface of said magnet and interference fitted in said bore to retain said magnet in said bore,

said bore having a portion of non-circular transverse cross section outboard of said retaining structure defining a bit-receiving socket

said retaining structure including a discrete retaining member friction fitted in said bore outboard of said magnet,

said retaining member being generally bowl-shaped and convex towards said magnet,

said retaining member and said inner end surface cooperating to retain said magnet therebetween.

KEY:  
Reasons for allowance

Alleged recapture areas

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